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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,177

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Wilfried Matthis

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EXAMINER

REIMERS, ANNETTE R

ART UNIT

PAPER NUMBER

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/726,177	Applicant(s) MATTHIS ET AL.	
	Examiner Annette R. Reimers	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006 and 02 February 2007.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-7, 11-15, 21-23 and 25 is/are rejected.
 7) ☒ Claim(s) 8-10, 16, 18-20 and 24 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on November 20, 2006 and February 02, 2007 have been entered.

Drawings

Figure 7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 9-10 are objected to because of the following informalities: In claim 9, applicant claims a pressure element comprising a second U-shaped recess and third and fourth free legs, each of which implies that the pressure element has a first U-

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shaped and first and second free legs. Examiner suggests amending claim 9, for example, as follows: wherein the pressure element comprises a U-shaped recess with a bottom corresponding to the U-shaped recess of the holding element, the U-shaped recess of the pressure element forming two or first and second free legs having a free end in a plane and wherein the abutment is formed by the free end. Examiner further suggests amending claim 10, for example, as follows: wherein the rod has a diameter and wherein a distance from the bottom of the U-shaped recess of the pressure element to the free end of the pressure element is smaller than the diameter of the rod. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, 11-13, 21-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (U.S. Patent Number 6,224,598).

Jackson discloses an implant comprising a rod, e.g. 6, a shaft, e.g. 11, a holding element, e.g. 13, monoaxially connected and formed in one piece with the shaft, wherein the holding element comprises a recess with a U-shaped cross section for receiving a rod, the recess forming two free legs having at one end thereof an inner thread, a closure element, e.g. 1, for fixation of the rod inserted into the U-shaped recess, the closure element having an outer thread cooperating with the inner thread of the legs and having a lower side which contacts the rod and an abutment (see figure 1) directly contacting the closure element to limit a tilting of the closure element about the rod at the time of final tightening of the closure element in the holding element (see figures 1 and 3-6). The abutment is a support surface for a section of the lower side of the closure element (see figure 1). The U-shaped recess of the closure element has a bottom and the rod has a diameter, wherein a distance from the bottom of the U-shaped recess to the support surface is smaller than the diameter of the rod (see figure 1). The abutment is an inward projecting surface on the inside of the free legs of the holding element (see figures 1). The inner thread of the legs and the outer thread of the closure element are formed as a thread selected from the group consisting of a metric thread, a saw tooth thread, a thread having a load flank having a negative angle, and a flat thread (see figure 1). The device of Jackson performs the method of fixing a rod relative to a bone, as disclosed in claims 13 and 25.

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Claims 1-3, 5, 11-15, 21-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lombardo (U.S. Patent Publication Number 2001/0001119).

Lombardo discloses an implant comprising a rod, e.g. 8, , a shaft, e.g. 1, a holding element, e.g. 12, and a pressure member, e.g. 7, wherein the holding element comprises a recess with a U-shaped cross section for receiving a rod, the recess forming two free legs having at one end thereof an inner thread, a closure element, e.g. 11,, for fixation of the rod inserted into the U-shaped recess, the closure element having an outer thread cooperating with the inner thread of the legs and having a lower side which contacts the rod and an abutment (see figures 1-3) directly contacting the closure element to limit a tilting of the closure element about the rod at the time of final tightening of the closure element in the holding element (see figures 1-4). The abutment is a support surface for a section of the lower side of the closure element (see figures 1-3). The U-shaped recess of the closure element has a bottom and the rod has a diameter, wherein a distance from the bottom of the U-shaped recess to the support surface can be smaller than the diameter of the rod. The abutment is an inward projecting surface on the inside of the free legs of the holding element (see figures 1-3). The inner thread of the legs and the outer thread of the closure element are formed as a thread selected from the group consisting of a metric thread, a saw tooth thread, a thread having a load flank having a negative angle, and a flat thread (see figures 1-3). The shaft has a screw element having a bone thread, e.g. 15, and a head, e.g. 14, at one end that is polyaxially connected to the holding element. The

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device of Lombardo performs the method of fixing a rod relative to a bone, as disclosed in claims 13 -15 and 25.

Claims 1-3, 5, 11-15, 21-22 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Jackson (U.S. Patent Number 6,368,321).

Jackson discloses an implant comprising a rod, e.g. 5, a shaft, e.g. 10, a holding element, e.g. 11, and a pressure member, e.g. 14, wherein the holding element comprises a recess with a U-shaped cross section for receiving a rod, the recess forming two free legs having at one end thereof an inner thread, a closure element, e.g. 66,, for fixation of the rod inserted into the U-shaped recess, the closure element having an outer thread cooperating with the inner thread of the legs and having a lower side which contacts the rod and an abutment (see figures 1-4) directly contacting the closure element to limit a tilting of the closure element about the rod at the time of final tightening of the closure element in the holding element (see figures 1-4). The abutment is a support surface for a section of the lower side of the closure element (see figures 1-4). The U-shaped recess of the closure element has a bottom and the rod has a diameter, wherein a distance from the bottom of the U-shaped recess to the support surface can be smaller than the diameter of the rod. The abutment is an inward projecting surface on the inside of the free legs of the holding element (see figures 1-4). The inner thread of the legs and the outer thread of the closure element are formed as a thread selected from the group consisting of a metric thread, a saw tooth thread, a thread having a load flank having a negative angle, and a flat thread (see figures 1-3). The shaft has a screw element having a bone thread, e.g. 19, and a

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head, e.g. 22, at one end that is polyaxially connected to the holding element. The device of Jackson performs the method of fixing a rod relative to a bone, as disclosed in claims 13 -15 and 25

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (U.S. Patent Number 6,224,598).

Jackson discloses the claimed invention except for the distance being smaller than the diameter by an amount from about 1 % to about 7.5 % of the diameter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Jackson with the distance being smaller than the diameter by an amount from about 1 % to about 7.5 % of the diameter, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lombardo (U.S. Patent Publication Number 2001/0001119).

Lombardo discloses the claimed invention except for the distance being smaller than the diameter by an amount from about 1 % to about 7.5 % of the diameter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Lombardo with the distance being smaller than the diameter by an amount from about 1 % to about 7.5 % of the diameter, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (U.S. Patent Number 6,368,321).

Jackson discloses the claimed invention except for the distance being smaller than the diameter by an amount from about 1 % to about 7.5 % of the diameter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Jackson with the distance being smaller than the diameter by an amount from about 1 % to about 7.5 % of the diameter, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Allowable Subject Matter

Claims 8-10, 16, 18-20 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-16 and 18-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER